

II. Rejection of Claims 1-22 under 35 U.S.C. § 103(a)

The Examiner rejects claims 1-22 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,540,791 to Dias (Dias), in view of U.S. Patent No. 6,260,556 to Legrand et al. (Legrand), and further in view of U.S. Patent No. 6,423,306 to Caes et al. (Caes). Specifically, the Examiner alleges that Dias teaches a hair bleaching composition comprising polydecene, nonionic amphiphilic polymers, peroxygenated salt, alkaline agent, and surfactants as recited in the rejected claims. Office Action, page 3. The Examiner admits that Dias "differs from the instant application in that it does not disclose the particular peroxygenated salts of instant claim 11 or the hydrogen peroxide of instant claims 21 and 22." *Id.* To remedy this deficiency, the Examiner relies on Legrand and alleges that Legrand teaches anhydrous compositions for bleaching keratin fibers containing the sodium persulphate of instant claim 11 and hydrogen peroxide. *Id.*

The Examiner further admits that Dias "differs from the instant application in that it does not disclose the polydecene of claims 1, 3, 18, and 20-22, in which at least 30 carbon atoms are presented in the present formula." *Id.* at 4. To remedy this deficiency, the Examiner argues that it would have been obvious to incorporate such a polydecene into Dias because Dias "teaches clearly that polydecene compounds having more than 19 carbon atoms can be used in the composition (see col. 23, lines 1-12)." *Id.*

Finally, the Examiner admits that Dias "differs from the instant application in that it does not disclose the gelling agent of instant claims 1, 6-9, 18, 21 and 22." *Id.* To remedy this deficiency, the Examiner relies on Caes and alleges that Caes discloses compositions that "consist[] of the gelling agent of instant claims 1, 6-9, 18, 21 and 22."

Id. The Examiner concludes that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to make an anhydrous paste comprising a peroxygenated salt, an alkaline agent, a polydecene, and a gelling agent, as taught by Dias, in view of Legrand, and further in view of Caes. *Id.* at 5. Applicant respectfully traverses for at least the following reasons.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met, including that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and that the prior art reference (or references when combined) must teach or suggest all the claim limitations of the rejected claims. M.P.E.P. § 2143. The teaching or suggestion to make the claimed combination must be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 490, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). In addition, the Examiner must consider the prior-art reference in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. M.P.E.P. § 2141.02 (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983)) (emphasis in original).

In the present case, the Examiner has failed to show that the references teach or suggest all the claim limitations recited in the rejected claims.

More specifically, Dias does not teach or suggest a composition that is an anhydrous paste as recited in, for example, present claim 1. Indeed, Dias teaches away from the present invention by addressing the need "for a single solution hair bleaching product." Dias, col. 2, lines 9-10 and 24-25 (emphasis added). Dias discloses

that its composition comprises, "as an essential feature," a buffering system comprising water soluble compounds. *Id.* at col. 7, lines 2-10, 17-18, 60-61. Further, Dias discloses that its composition may comprise a diluent, which is preferably water. *Id.* at col. 44, lines 65-67. Also, all of the examples disclosed in Dias use water as a diluent. *Id.* at col. 50, line 35. All of these disclosures teach firmly away from an anhydrous product.

Additionally, as admitted by the Examiner, the percentages of ingredients in Dias's composition differ from those in the presently claimed composition. Office Action, page 5. This reflects a further fundamental difference between Dias's invention, which is directed to a bleaching solution, and the present invention, which is directed to an anhydrous paste. For example, Dias discloses that its composition may comprise, among a laundry list of organic conditioning oils, polydecene in an amount ranging from about 0.05% to about 3% by weight of the composition. Dias, col. 22, line 42 - col. 25, line 15. This disclosure of Dias teaches away from the amount of the at least one polydecene ranging from 15% to 35% by weight of the total weight of the paste as recited in, for example, present claim 1. Therefore, contrary to the Examiner's allegations, it would not have been obvious for one of ordinary skill in the art to attain the parameters of the instant claims by routine experimentations.

Further, the Examiner has failed to point to any evidence of a suggestion or motivation to pick and choose polydecene from the laundry list of the organic conditioning oils disclosed in Dias (see *id.*), let alone the specific polydecene of formula $C_{10n}H_{[(20n)+2]}$, wherein n ranges from 3 to 9, as recited in, for example, present claim 1. Picking and choosing among isolated disclosures in the references to deprecate the

claimed invention amounts to improper hindsight reconstruction and is prohibited under section 103. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

Here, the Examiner has adopted impermissible hindsight in support of the obviousness rejection.

As for the secondary references, the Examiner merely relies on Legrand and Caes for the disclosure of specific peroxygenated salts, hydrogen peroxide, and gelling agents. See Office Action, pages 3-4. Neither Legrand nor Caes remedies the deficiencies of Dias as set forth above.

Accordingly, as the Examiner has failed to establish a *prima facie* case of obviousness, Applicant respectfully requests this rejection be withdrawn.

III. Obviousness-Type Double Patenting

The Examiner also provisionally rejects claims 1-22 under non-statutory obviousness-type double patenting as being unpatentable over claims 1-47 of Legrand in view of Dias, and in further view of Caes.¹ Office Action, pages 6-7. Applicant respectfully traverses this rejection for at least the following reasons.

First, it is improper for the Examiner to provisionally reject claims 1-22 under non-statutory obviousness-type double patenting, because the primary reference, *i.e.*, Legrand, is not a conflicting pending application, but an issued patent. See M.P.E.P. § 804, ¶ 8.37, Examiner Notes 1 and 2.

¹ Applicant respectfully submits that the Examiner erred in stating that "Claims 1-22 are provisionally rejected . . . over claims 1-47 of U.S. Patent No. 6,260,556 ('556) in view of Legrand, et[] al. (U.S. Patent No. 6,260,556) . . ." See Office Action, page 6. Based on the alleged reasons in support of this rejection as set forth in the Office Action, pages 6-7, Applicant reasonably believes that the Examiner intends to reject claims 1-22 under non-statutory obviousness-type double patenting over claims 1-47 of Legrand in view of Dias and further in view of Caes. Therefore, Applicant respectfully requests clarification of the record.

Additionally, the Examiner has failed to show that the references teach or suggest all the elements of the rejected claims. Specifically, as discussed above, the Examiner has failed to point to any evidence of a suggestion or motivation to pick and choose polydecene among the various organic conditioning oils disclosed in Dias, let alone the specific polydecene of formula $C_{10n}H_{[(20n)+2]}$, wherein n ranges from 3 to 9, as recited in, for example, the present claim 1. In addition, even if polydecene is chosen, the disclosure of the amount of polydecene in Dias, i.e., ranging from about 0.05% to about 3% by weight of the composition, teaches away from the amount of the at least one polydecene ranging from 15% to 35% by weight of the total weight of the paste as recited in, for example, claim 1 of the present invention. Furthermore, the Examiner has failed to point to any evidence of a suggestion or motivation to include polydecene in Legrand's claimed composition.

Therefore, as the Examiner has failed to establish a *prima facie* case of obviousness, Applicant respectfully requests this rejection be withdrawn

CONCLUSION

In view of the foregoing remarks, Applicant respectfully submits that the pending claims are not obvious in view of the references cited against the rejected claims. Applicant therefore requests reconsideration of the application, and the timely allowance of the pending claims.

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If there is any fee due in connection with the filing of this Response, please
charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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